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Nicholas Mesiti, Esq. Heslin & Rothenberg, P.C. 5 Columbia Circle Albany, NY 12203			DAVIS, CASSANDRA HOPE	
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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/783,366

Filing Date: February 14, 2001

Appellant(s): BROCKLEY ET AL.

David A. Pascarella
For Appellant

EXAMINER'S ANSWER

35
This is in response to the appeal brief filed April 26, 2004 and

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER mailed

July 20, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

In the Argument section of the appeal brief the heading for the subgroups (i), (ii), and (iii) are incorrect, however, the appellant appears to correctly list and discuss the correct claims in the texts of the argument section for these groups.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

405,678	RAND	6-1889
861,822	FEHER	7-1907
5813546	WILSON	9-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al, U. S. Patent 5,813,546 in view of Feher, U. S. Patent 861,822 and Rand, U. S. Patent 405,678. Wilson teaches a cap display apparatus 11 comprising an actual sports related object such as hat usable by a participant engaging in a sport. Wilson teaches that the hat can be associated with a particular sports or team or commemorating a special events such as baseball games, golf tournaments, automobile races and the like. (Column 1, lines 11-17). Wilson also teaches backing material 33 having a display surface 35 and a cutout 63 for displaying a ticket (not shown), wherein the ticket

has conventionally indicia thereon such as the name, date, or features relating to sports or event.

Wilson also teaches a transparent cover or window 13, wherein the cover has a first planar portion 16 serving to buttress the backing layer and ticket and a second hollow portion 15 conforming to the shape of the hat 21.

In addition, Wilson teaches a support frame 41 having a central display opening (not labeled) for displaying the hat, transparent cover, backing material, and ticket. The frame is formed with a forward portion (curved front surface of the front retaining edge 43) and rear portion (rear retaining edge 45).

The support frame has a forward interface (the rear surface of front retaining edge 43) and a rear interface (rear retaining edge 45), wherein the front and rear interface serves to secure the transparent cover or window 13, the backing, the ticket, and rigid back 39 within the open interior of the frame so that the hat and backing are visible.

As an optional feature, Wilson teaches a secondary display section 63 formed by removing some of the backing material 59 below the hollow portion 15. (See figure 3). This secondary display section 63 can be sized

and shaped to accommodate a single ticket (not shown), or a number of tickets in a fan layout. *This permits the cap's collector to simultaneously display tickets to an event associated with the cap (not shown), wherein the ticket can correspond to the picture on a layer.* (See column 3, lines 41-47).

Wilson does not teach the display surface of the backing material having a picture thereon and the forward and rearward interface.

Rand teaches a three-dimensional picture comprising a frame **A** having a rebate or rear recess (first interface portion), a transparent cover **C²**, a backing plate **B** having a picture thereon, and a three-dimensional object (bird).

Feher teaches an embossed picture comprising a frame 1 having a rebate or rear recess (forward interface **a**), a transparent cover sheet 7, a foundation plate (backing 2) having a facing of paper 4 mounted thereon, and an embossed or three-dimensional member 6. The plate or backing 2, embossed or three-dimensional member 6, and sheet 7 are retained within the recess of the frame 1 by a suitable backing plate 9. The plate is held within the frame by tacks. The rebate or rear recess corresponds to the forward interface and the combination of the tack 10 and the backing 9 corresponds to the rear interface.

The peripheral edges of the sheet 7 are adapted to lie flush with the front surface of the paper 4 and are held in engagement therewith by molding 8 of frame 1.

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the display surface of the backing material of the cap display apparatus taught by the Wilson with a picture on the backing material that corresponds with the three-dimensional object as taught by Rand to enhance the appearance of the display.

In addition, it would have been obvious to one having ordinary skill in the art at the time this invention was made to mounted the display taught by Wilson and Rand within the frame taught by Feher as an alternate frame means whereby the display can be selectively inserted and removed from the rear of the frame.

With respect to claim 5, Wilson teaches a window piece 13 made of a sheet of transparent plastic. (See col. 2, lines 16-17).

With respect to claim 6 and 21, the window piece 13 has a rear surface 37 adapted to contact the front display surface 35 of the backing and hollow form 15 including a crown section 17 and a bill section 19,

designed to hold and cup the cap 21. (See column 2, lines 29-43 and lines 60-65).

With respect to claim 7 and 22, Wilson teaches the support comprises a frame 41 and backing 39.

With respect to claim 8, 9, 23 and 24, Wilson teaches a frame with a front semicircular defining a front retaining edge or stop 43 abutting the front surface of the window piece 15 and a rear retaining edge 45 corresponding the to fastener. Feher teaches a frame with a rear rebate or recess **a** having forward interface 8 (the rear surface of the front fame member abuts the front surface of the clear celluloid sheet 7). Feher also teaches fastener in the form of a tack 10 to hold the backing plate 9 in place.

With respect to claim 13 and 28, Rand teaches the back of the frame may be painted, colored, or arranged with any design or picture from a pleasing background. (See lines 28-33). Since the appellant dose not disclose that the photograph solves any stated problem or is for any particular purpose, it appears that construct picture in any suitable manner as taught by Rand would perform equally well.

With respect to claims 37-45, since the appellant does not disclose that the specific scene described in the claims solves any stated problem or is for any particular purpose, it appears that any scene related to the object would perform equally well.

(11) Response to Argument

Appellant's arguments with respect to Group 1, Subgroup (i): claims 1, 5-9, 13, 17, 21-24, 28 and 32 (Claims listed in heading are 1, 5-9, 13, 17, 21-24, 28 and 37-42) have been considered but are moot in view of the new ground(s) of rejection.

The appellant argues that the prior art of record does not teach 1) a cover having a first transparent portion that extends over the picture and second transparent portion configured for receiving the sports related object, 2) a sports related object or representation thereof which is used by a participant in engaging in the sport, 3) a picture illustrating a scene relating to the sports related object, 4) the sports related object being visually associated with the picture, and 5) the sports related object not obscuring the picture.

Specifically, the appellant argues that Wilson the primary reference does not teach 1) display surface having a scene relating to the sports

related object, 2) the sports related object being visually associated with the picture, and 3) the sports related object not obscuring the picture.

As stated above, Wilson teaches a backing member made of conventional matting material and a secondary display section 63 formed by removing some of the backing material 59 below the hollow portion 15. (See figure 3). This secondary display section 63 can be sized and shaped to accommodate a single ticket (not shown), or a number of tickets in a fan layout. *This permits the cap's collector to simultaneously display tickets to an event associated with the cap (not shown).* (See column 3, lines 41-47).

The examiner considers the ticket and the indicia thereon can correspond to a picture having indicia associated with the sports object, namely, the cap. Nevertheless, Rand teaches a display comprising a picture frame, a bird, and a back having a front surface which may be "painted, colored, or arranged with any design or picture for a pleasing background". The examiner maintains the position that the bird is an object used by the participant in the sport of hunting by providing an object or target in which the hunter aims. The picture depicted in figure 1 clearly shows a nature scene corresponding to

the environment in which the bird inhabits; thereby providing a scene related to the object, namely the bird.

In addition, although the bird is placed in front of the backing with the picture, the bird is place is such a way as to blend into the scene depicted in the background picture.

With this in mind the examiner maintains the position that device taught by Wilson can be modified to include a picture on the backing relating to the hat as taught by Rand.

Feher is cited to show structure of the frame as claimed. Feher clearly show a picture frame having a rearward facing rebate, wherein the transparent sheet, a three-dimensional display and the backing are secured therein utilizing a tack. Feher clearly teaches the front of the transparent member abutting the rear of the frame member within the rebate.

With respect to claims 32 and 43-45 the appellant argues that Wilson, Rand nor Feher teach a scene comprising an image of a person associated with a sports related object as claimed. The examiner contends that the prior art of record does not specifically show a person associated with the sports related object, however, Rand clearly shows a background scene associated with a sports related object, namely, the bird. Since the

appellant does not disclose that a scene including a person any stated problem or is for particular purpose, it appears that providing any suitable related background scene as taught by Rand would perform equally well in enhancing the aesthetic appearance of the device. In addition, the examiner maintains the a scene including a person does not have an unobvious relationship with the device.

With respect to claim 38, 41, and 44, the appellant argues that the prior art of record does not teach a scene comprising a scene illustrating an actual location associated with the sports related object. The examiner maintains that the scene depicted in Rand shows natural habitat of the bird on display and thereby shows the location in which the hunting would take place.

With respect to claims 32 and 43-45 the appellant argues that Wilson, Rand nor Feher teach a scene comprising scene illustrating an actual location commemorating an occasion where a sports related object is used. Since the appellant does not disclose that a scene illustrating an actual location commemorating an occasion where a sports related object is used any stated problem or is for particular purpose, it appears that providing any suitable related background scene as taught by Rand would perform

equally well in enhancing the aesthetic appearance of the device. In addition, the examiner maintains the a scene illustrating an actual location commemorating an occasion where a sports related object is used does not have an unobvious relationship with the device.

RESPONSE TO ISSUES IN REPLY BRIEF

Issue No. 1.

The applicant argues that Wilson et al. does not support the statement that “the ticket can correspond to the picture of a layer”. Although Wilson does not explicitly recite the ticket is a picture, the examiner maintains the position that the ticket can correspond to the claimed picture on a layer.

Issue No. 2.

The examiner maintains the position that the ticket is a picture. In addition, Wilson clearly recites that the ticket to an event is associated with the cap. (Column 3, lines 42-47).

Issue No. 3.

The applicant argues that Wilson does not teach display surface of the backing material having a picture thereon. Specifically, the applicant disagrees that bird taught by Rand is an object used by the participant in

the sport of hunting and therefore, the combination of Wilson and Rand fail to disclose a sports related object usable by a participant in engaging in a sport and a picture illustrating a scene relating to the sports related object.

The examiner maintains the position that the bird and the scene picture depicted in the nature scene correspond to the environment in which the bird inhabits, wherein the bird is a sports related object. It is obvious in light of Rand that a scene, such as ball field, related to the cap can be positioned behind the cap of the invention taught by Wilson to enhance the appearance of the device.

Issue No. 4.

The applicant argues that Feher discloses an embossed picture showing a scene of a historical or biblical nature. The examiner maintains that Feher is cited to show the structure of the frame and a frame adapted to support a three-dimensional display. This position is clearly pointed in the rejection of the claims.

In addition, the examiner disagrees with the applicant that Feher raises a new ground of rejection. Please see page 3 of final office action mailed August 11, 2003.

Issue No. 5-7.

Claims 32 and 37-45 all relate to the particular image depicted in scene. The examiner maintains that the particular scene and/or indicia is a matter of design. The important consideration is that the scene relates to the object. Rand is cited to clearly show a display having a sport related object and a background scene related to the object.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Cassandra Davis
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Art Unit 3611

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August 15, 2005

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